

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

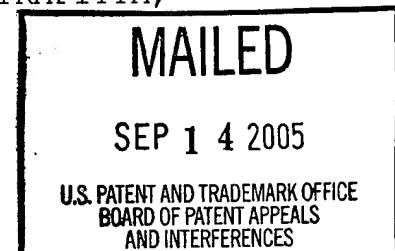
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN W. MASTERS, MATTHEW PIETRAFITTA,
and THERESE VELDE

Appeal No. 2005-1380
Application No. 09/944,314

HEARD: AUGUST 10, 2005



Before WALTZ, KRATZ, and PAWLIKOWSKI, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's non-final rejection of claims 1 through 3, 5 through 10 and 12 through 17, which are the only claims pending in this application. Although the action appealed from was a non-final rejection, we have jurisdiction since the claims were twice rejected. See 35 U.S.C. § 134 (2003) and *Ex parte Lemoine*, 46 USPQ2d 1420, 1422-23 (Bd. Pat. App. & Int. 1998).

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According to appellants, the invention is directed to preventing a hearing instrument from slipping out of the ear and creating an outward appearance that blends with the wearer's ear by giving a textured, non-smooth finish to the outer surface of a hearing instrument shell (Brief, page 2).

Appellants state that the claims fall "roughly" into three groups (Brief, page 3). However, as correctly stated by the examiner (Answer, page 3, paragraph (7)), the claims stand or fall together since appellants have not positively stated that the claims do not stand or fall together nor have they presented specific, substantive reasons for the separate patentability of individual claims. See 37 CFR § 1.192(c)(7) (2003); *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Accordingly, we select claim 1 as the broadest representative independent claim and decide the first six rejections on the basis of this claim alone. We select claim 6 from the grouping of claims in the rejection based on 35 U.S.C. § 103(a). Representative independent claim 1 is reproduced below:

1. Imparting a texture to a hearing instrument shell.

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The examiner relies on the following references as evidence of unpatentability:

Walter	3,567,871	Mar. 02, 1971
Hoerkens	4,803,853	Feb. 14, 1989
Bowser et al. (Bowser)	5,581,627	Dec. 03, 1996
Yoest et al. (Yoest)	6,097,825	Aug. 01, 2000
Widmer et al. (Widmer)	6,595,317 B1	Jul. 22, 2003 (filed Sep. 25, 2000)

The following rejections are before this merits panel for review in this appeal:

(1) claims 1, 2, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by the admitted prior art at page 1, ll. 4-10, of the specification (Answer, page 3, referring to the prior Office action dated May 18, 2004);

(2) claims 1-3 and 8-10 stand rejected under section 102(b) as anticipated by Walter (*id.*);

(3) claims 1-3 and 8-10 stand rejected under section 102(b) as anticipated by Bowser (*id.*);

(4) claims 1-3, 6, 8-10, 13 and 16 stand rejected under section 102(b) as anticipated by Hoerkens (*id.* at page 4);

(5) claims 1, 2, 8 and 9 stand rejected under section 102(b) as anticipated by Yoest (*id.*);

(6) claims 1-3, 5, 7-10, 12 and 14-17 stand rejected under section 102(b) as anticipated by Widmer (*id.*);¹ and

¹Since appellants' filing date for this application is after the filing date of Widmer but before the issue date of Widmer, we presume the examiner erroneously stated this rejection in the Answer as based on section 102(b) while previously stating the statutory basis as section 102(a) in the prior Office action dated May 18, 2004 (see page 3). Since appellants do not dispute the statutory basis for this rejection (see the Brief and Reply

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(7) claims 6 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Widmer in view of Hoerkens (*id.*).

Based on the totality of the record, including due consideration of the opposing arguments in the Brief, Reply Brief, and the Answer, we *affirm* all rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Rejections based on Section 102

With respect to the subject matter of claim 1 on appeal, the examiner finds that (1) the admitted prior art (specification, page 1, ll. 4-10) discloses imparting a smooth texture to the outer surface of a hearing instrument shell; (2) Walter, Bowser, Hoerkens, Yoest and Widmer each discloses imparting a non-smooth texture to the outer surface of a hearing instrument shell (Office action dated May 18, 2004, pages 2-3). The examiner states that “[b]oth the appellant’s [sic, appellants’] arguments and the case itself revolve around one main issue: **The meaning of**

Brief in their entirety), we consider the examiner’s error harmless.

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the term 'texture.'" Answer, page 4, paragraph (11). The examiner construes "texture" to reasonably include smooth and non-smooth textures (Answer, pages 4-5).

Appellants argue that texture is defined in their specification as only including non-smooth finishes (Brief, page 4). Appellants further argue that neither Walter nor Bowser concerns a "hearing instrument" (Brief, page 5). Appellants also argue that Hoerkens lacks the procedural step of "imparting a texture" since this reference adds a component separate from the hearing aid to create a texture (*id.*). Appellants argue that the examiner relies on an inapposite dictionary definition of "texture" which is not consistent with the use of this term in the specification (Brief, page 6). Finally, appellants argue that Widmer only discloses ribs on the surface of the hearing instrument shell and these do not constitute a "texture" or create the appearance of "natural skin" (Brief, pages 6-7).

It is implicit in our review of the examiner's anticipation analyses that we must first correctly construe the claim to define the meaning and scope of any contested limitations. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). "The Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely

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on the basis of claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. Jul. 12, 2005) (en banc), quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). Of course, limitations from the specification should not be imported into the claims, even if the preferred embodiment is the only embodiment described, absent clear disclaimer in the specification. See *In re Am. Acad. of Sci. Tech. Ctr.*, *supra*; see also *Comark Commc'ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) ("there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification").

Contrary to the examiner's position (Answer, page 4), the meaning of the term "texture" is not the only contested limitation. As stated above, appellants also contest the meaning of the terms "hearing instrument" and "imparting" (Brief, page 5; Reply Brief, page 2). Accordingly, we must determine the proper meaning and scope of all contested limitations. See *Gechter v. Davidson*, *supra*. First, we turn to appellants' specification for

any definitions or guidelines for the term "texture." Appellants teach that the shell of the hearing instrument is provided with a "textured finish" (abstract). Appellants disclose that the texture "may be a series of lines 50, equally or unequally spaced (Figures 3 and 4), or a plurality of shapes (e.g., ovals and circles in Figures 5 and 6, respectively), or some other pattern, predetermined or randomly generated." Specification, page 5, ll. 1-6. Therefore we need not consult any extrinsic evidence, as appellants' specification clearly defines "textured" as a series of lines or shapes in any order or spacing that lie on a surface of the hearing instrument shell. "[T]he specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term." *Phillips v. AWH Corp.*, 415 F.3d at 1315, 75 USPQ2d at 1327 (internal quotations omitted).

We note that the specific embodiments from the specification that the texture may also have the property or characteristic of being "non-smooth" (specification, page 2, l. 8), or that the textured finish produces "an appearance closer to that of natural skin" (specification, page 2, ll. 10-11), have not been imported into claim 1 on appeal (see claim 3 on appeal). Appellants cite *Marks' Standard Handbook for Mech. Eng'rs (Marks')* on page 6, ll.

14-17, of the specification, for "particulars of surface texture." On page 13-76, Marks' teaches that surfaces that are polished still exhibit a "texture," and thus the broadest reasonable interpretation of "texture" would include "smooth" as well as "non-smooth" finishes. We also determine that "an appearance closer to that of natural skin" is merely a subjective result of the texture but does not define or limit what a "texture" encompasses. See Marks' at page 13-77 (as discussed by the examiner in the Answer, page 4, last paragraph).

Although appellants' "hearing instrument" is specifically taught to be capable of remaining "within the ear canal" (specification, page 2, ll. 8-10), the term "hearing instrument" is not defined in the specification. Accordingly, we agree with the examiner that the broadest reasonable interpretation of this term encompasses any instrument or device that assists or aids in hearing, regardless of whether the instrument can be inserted in a human ear canal, and thus includes hearing aids, telephone receivers, earphones, etc. We note that there is no express disclaimer in the specification limiting the scope of this term, nor any claim language limiting this term to instruments residing in the ear canal.

Finally, we determine that "imparting" is not defined in the specification, although appellants use the phrase "a texture is imparted to the surface" and "imparting à pattern to the surface or layers" (specification, page 2, ll. 14-15; page 3, ll. 5-8). Appellants also use the word "creating" synonymously with "imparting" (specification, page 2, ll. 8-9). Accordingly, we turn to the extrinsic evidence of a dictionary definition wherein "impart" means "to give or grant (what one has or of what one has) or give rise to (in another) by contact, association or influence."² This definition comports with the context of the word "imparting" as used throughout the specification. Accordingly, we adopt this meaning for the word "imparting."

In view of our claim construction as discussed above, we agree with the examiner that claim 1 on appeal is anticipated by the admitted prior art, Walter, Bowser, Hoerkens, Yoest, or Widmer. Appellants argue that the word "texture" and the phrase "imparting a texture" appear nowhere in the excerpt of the prior art on page 1, ll. 4-10, of the specification (Brief, page 5). This argument is not persuasive since the "polishing phase" of

²See Webster's Third New International Dictionary, 1131 (Gove, ed., G. & C. Merriam Co., Springfield, Mass., 1971).

the prior art used to achieve a smooth or glossy finish inherently must "give" or "impart" by contact a "texture" as construed above (see *Marks'*, page 13-76; specification, page 1, ll. 4-6).

With regard to the rejections over Walter or Bowser, appellants argue that neither reference concerns a "hearing instrument" (Brief, page 5). Appellants' argument is not persuasive in view of our claim construction of the term "hearing instrument" above. Appellants also argue that nowhere in Bowser is there anything approaching the appellants' claimed "texture" (*id.*). This argument is not persuasive since Bowser clearly discloses different designs on the cover (or "outer shell") of each earphone, which designs are a "texture" within the meaning discussed above as set forth in appellants' specification (see Bowser, Figures 1B, 5A, and 5B; col. 3, ll. 34-54; Office action dated May 18, 2004, page 2).

With regard to the rejection over Hoerkens, appellants argue that Hoerkens' ornamental mesh screen covering is a component separate from the hearing aid and thus does not constitute "imparting a texture" (Brief, page 5). This argument is not persuasive in view of our claim construction given to the word "imparting" as discussed above. Appellants do not contest that

the mesh screen of Hoerkens gives rise to a "texture," as defined above as a series of lines on the surface of the hearing instrument shell (e.g., see Figures 1 and 3). The step of "imparting" is achieved by Hoerkens when the mesh screen is associated with or in contact with the hearing instrument shell to produce a "texture" ("impart" means to give or grant or give rise to by contact, association, or influence, as defined above). The claimed phrase "imparting a texture" does not limit the number of components, but is merely construed as giving rise to a series of lines or shapes on the surface of the hearing instrument shell. Additionally, we note that the mesh screen of Hoerkens may lie on the surface of the hearing instrument shell or may be an integral part of the hearing aid (see col. 2, ll. 31-34 and 39-41).

With regard to the rejection over Yoest, appellants argue that this reference "does not disclose, teach, or suggest, there or anywhere within the document, the concept of imparting a texture" (Brief, page 6). This argument is not persuasive since Yoest discloses that the housing of a hearing aid can have a sponge-like layer as a cover, this giving rise to a "texture" or series of lines to the hearing instrument shell (see Figure 4, 92a; col. 1, ll. 59-64). As discussed above, claim 1 on appeal

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is not limited to any number of components as long as the surface of the hearing instrument shell is associated or "imparted" with a "texture" or series of lines.

With regard to the rejection over Widmer, appellants argue that neither the ribs nor grooves of Widmer constitute a "texture" or the step of "imparting a texture" as described and claimed (Brief, page 7). Appellants further argue that the surface of Widmer remains smooth and untextured while Widmer fails to address the problems of slippage and appearance solved by appellants' invention (*id.*; Reply Brief, page 3). These arguments are also not persuasive in view of our claim construction as discussed above. Widmer clearly discloses "imparting" or associating the ribs 51 on the surface of the hearing instrument shell, thus creating a "texture" or series of lines or shapes on the surface of the hearing instrument shell (see Figures 18 and 19; col. 12, ll. 49-63; and col. 13, ll. 10-13).

For the foregoing reasons, as well as those reasons set forth in the Answer and the Office action dated May 18, 2004, we determine that the examiner has established a *prima facie* case of anticipation in view of the reference evidence, which has not been adequately rebutted by appellants' arguments and evidence.

Accordingly, we affirm the rejections of claim 1, and the claims that stand or fall with claim 1, in each of the rejections on appeal based on section 102.

B. The Rejection based on Section 103(a)

With regard to claims 6 and 13, the examiner adopts the findings from Widmer as discussed above, additionally citing Hoerkens for the disclosure of applying waveforms (i.e., pleats) to the edges of one or more of the layers during the process of fabrication (Office action dated May 18, 2004, page 4). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to apply waveforms to the edges of one or more of the layers during the process of fabrication to permit the hearing aid to be worn inconspicuously (*id.*). We agree.

Appellants argue that Hoerkens does not disclose the words "waveforms" and "layers" (Brief, page 8). Appellants further argue that there is no teaching or suggestion in either reference to make the proposed combination (*id.*; Reply Brief, page 4). Finally, appellants argue that even if the references are properly combined, they still lack the element of "imparting a texture" (*id.*). Appellants' arguments are not persuasive. In view of our claim construction as discussed above, the step of

"imparting a texture" has been described by both Widmer and Hoerkens. As found by the examiner, the use of "pleats" that radiate are equivalent to "waveforms" (Answer, page 10; see Hoerkens, col. 1, ll. 24-25 and 45-48). Finally, the examiner has set forth a reasonable motivation or suggestion for combining these references (Answer, page 10), namely to enhance comfort and security of the hearing aid when worn (see Hoerkens, col. 1, ll. 25-28 and 45-56).³

For the foregoing reasons and those stated in the Answer and the Office action dated May 18, 2004, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments and evidence, we determine that the preponderance of the evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the examiner's rejection of claims 6 and 13 under section 103(a) over Widmer in view of Hoerkens.

³We also note that claims 6 and 13 have been included in the examiner's rejection under section 102(b) over Hoerkens alone (Answer, page 4). Since we have affirmed this rejection, and anticipation is the epitome or ultimate of obviousness, we would also affirm the rejection based on section 103(a). See *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

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C. Summary

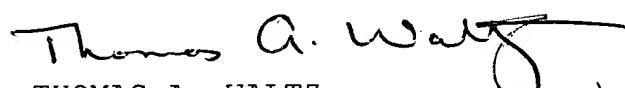
The rejections of (1) claims 1, 2, 8 and 9 under section 102(b) over the admitted prior art; (2) claims 1-3 and 8-10 under section 102(b) over Walter; (3) claims 1-3 and 8-10 under section 102(b) over Bowser; (4) claims 1-3, 6, 8-10, 13 and 16 under section 102(b) over Hoerkens; (5) claims 1, 2, 8 and 9 under section 102(b) over Yoest; (6) claims 1-3, 5, 7-10, 12 and 14-17 under section 102(a) over Widmer; and (7) claims 6 and 13 under section 103(a) over Widmer in view of Hoerkens are affirmed.

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The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

AFFIRMED

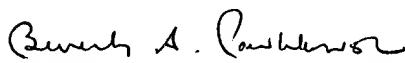


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)



PETER F. KRATZ)
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